

REMARKS

Claims 1-10 are pending.

Claim 9 is withdrawn.

Claims 1-8 and 10 are rejected under 35 USC 103(a) as being unpatentable over Kulakowski (US patent no. 6,731,455), Hanaoka (US Patent No. 6,144,519) and Utsumi (US Patent No. 5,967,339).

The claims are amended, and, thus, the pending claims remain for reconsideration, which is requested.

There may be conventional techniques related to "backup information" and a "diagnosis cartridge." However, none of Kulakowski, Hanaoka, Utsumi, and supplemental materials discloses, either expressly or implicitly, the feature of amended claim 1, namely, "wherein when the control board is replaced with a new control board, the backup control information is automatically transferred to the first memory of the new control board from the second memory of the diagnostic cartridge ~~when the control board is replaced~~."

As described in the specification of the present application on page 2, line 16 - page 3, line 5, conventional techniques have such drawbacks that:

... when the existing control board is removed from the library device and a new one is mounted, such as when it becomes necessary to replace the control board for maintenance or the like, location information must be prepared anew by measuring the locations of all the cartridges. Thus, long hours of work and great cost are required to restore the library device to working order.

There are library devices which employ another method according to which important information such as location information about cartridges is backed up in a secondary storage medium such as a flexible disk and when the control board is changed, the operator manually restores the system using the information backed up in the storage medium. However, this method may cause trouble due to operating errors. Besides, it requires increased maintenance time.

All the cited references upon which the Office Action relies for the rejections suffer from similar drawbacks described above. For example, the Examiner asserts that "backup information" is disclosed by Hanaoka. However, Hanaoka merely describes that at the time of power-on, if ROM data and FD data do not match each other, an operator is prompted to

operate a FD selection switch (see Hanaoka, Fig. 32 and the description related to this figure). Even if this data stored in FD is interpreted to correspond to "backup information," a manual error correction is expected to occur since a manual operation by a user is required.

In addition, the Office Action page 11, item 8 and page 4, line 12 to page 5, line 3 relies upon Utsumi's diagnostic cartridge 62 and the supplemental materials DLTsage cartridge to reject claim 1. However, DLTsage (Quantum) discusses a diagnostic cartridge for preventing backup failure. The Official Notice is traversed, because the language of claim 1 does not only require a diagnostic cartridge, but it is readily apparent that the language of claim 1 also requires a diagnostic cartridge ***that has a second memory and that stores backup information in the second memory***, namely "***one of the multiple cartridges is a diagnostic cartridge for the library device and the second memory installed in the diagnostic cartridge stores backup information*** which is the same as the control information stored in the first memory." In addition, claim 1 is amended to require "**when the control board is replaced with a new control board, the backup control information is automatically transferred to the first memory of the new control board from the second memory of the diagnostic cartridge** ~~when the control board is replaced.~~" DLTsage (Quantum) is silent on the language of amended claim 1.

The Office Action page 4 also alleges it is inherent that backup information would be activated as a backup/support mean while control board and memory in a library were replace. However, as suggested by MPEP 2131 and 2112, inherency requires the claimed feature to be necessarily present in the prior art even though not expressly discussed. There is no evidence that any of Kulakowski, Hanaoka, Utsumi or DLTsage (Quantum) necessarily require the language of amended claim 1 when none of these references discuss the details of a diagnostic cartridge and do not discuss details of actions to be taken when replacing a control board with a new control board. On the other hand, the inventor of the present application focused on the above-described drawbacks and found a solution as recited in independent claims 1 and 10, namely "**when the control board is replaced with a new control board, the backup control information is automatically transferred to the first memory of the new control board from the second memory of the diagnostic cartridge** ~~when the control board is replaced.~~"

The Office Action page 4 also discusses whether a prior art suggest the desirability of the claimed invention. However, Kulakowski, Hanaoka, Utsumi, and DLTsage don't discuss the circumstance in which a control board is replaced with a new control board, and how such a

circumstance should be handled, so the references don't serve as evidence of desirability of the language of amended claim 1.

In addition, the Office Action page 11 discusses combining Hanaoka with Kulakowski yields predictable results of claim 1, however, the language of claim 1 requires a diagnostic cartridge ***that has a second memory and that stores backup information in the second memory***, while Hanaoka only discusses a floppy drive storing back up of the ROM cell address translation table and usable when the ROM data does not match the FD data and Utsumi does not discuss the details of the diagnostic cartridge and what is stored on the diagnostic cartridge. And as discussed above, DLTsage (Quantum) discusses diagnostic to prevent backup failure. It is readily apparent that there is no evidence one skilled in the art would combine Kulakowski, Hanaoka, Utsumi and DLTsage and then notice a predictable result to further modify the combination to provide the language of amended claim 1, namely ***“one of the multiple cartridges is a diagnostic cartridge for the library device and the second memory installed in the diagnostic cartridge stores backup information which is the same as the control information stored in the first memory ... and ... when the control board is replaced with a new control board, the backup control information is automatically transferred to the first memory of the new control board from the second memory of the diagnostic cartridge when the control board is replaced.”***

None of the cited references contemplate any problem similar to those described above in the specification of the present application and thus, no solution to such problems is described in all the cited references. Accordingly, independent claims 1 and 10 would not have been obvious over the combination of the cited references.

Withdrawal of the rejections and allowance of the claims is requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,
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